

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 80

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

DAVID BARTZ and MARTIN G. CARSWELL

Junior Party,¹

v.

H. JACK MOORE, JR. and MARTIN ABALOS

Senior Party.²

Interference No. 104,180

Before URYNOWICZ, MARTIN and CRAWFORD, Administrative Patent Judge.

URYNOWICZ, Administrative Patent Judge.

REQUEST FOR RECONSIDERATION UNDER 37 CFR § 1.658(b)

On April 7, 2003, Bartz et al. (Bartz) filed a request for reconsideration under 37 CFR §1.658(b) (Paper No. 78) of our final decision of March 6, 2003 under 37 CFR §1.658(a) (Paper No. 77). Moore et al. (Moore) stands opposed (Paper No. 79).

¹ Application No. 08/299,360, filed September 1, 1994, now U.S. Patent No. 5,494,003, issued February 27, 1996. Assignors to Alzeta Corp., Santa Clara, California.

² Application No. 08/590,355, filed January 11, 1996. Assignors to American Water Heater Co. Accorded benefit of U.S. Application Nos. 08/333,871, filed November 3, 1994, now U.S. Patent No. 5,511,516, issued April 30, 1996; and 08/113,618, filed August 27, 1993, now abandoned.

A request for reconsideration is limited to specifying arguments raised by the parties at final hearing believed to have been misapprehended or overlooked by the Board. The essence of Bartz's arguments in its request for reconsideration is that it does not agree with the reasoning and conclusions reached by the Board in its decision. Points raised in the request that were raised at final hearing were fully considered by the Board in reaching its decision and we see no reason to make any change therein. 37 CFR § 1.658(b). However, we make the following comments with respect to Bartz's arguments raised as Items I-VI.

Item I.

In Item I at pages 3-6 of its request, Bartz argues to the effect that at final hearing the Board incorrectly dismissed its argument that Moore's involved claims are unpatentable under 35 U.S.C. §§ 102(f) and 103 on the basis that Bartz filed no motion for judgment under 37 CFR § 1.633(a) on this basis. It is urged that Bartz was precluded by 37 CFR § 1.633(a)(2) from raising the issue by motion during the preliminary motions period. The contention is made that such a motion cannot be made where the prior art is § 102(f) prior art derived from another because such derivation can only be determined through the taking of evidence.

No merit exists in Bartz's position that the Board incorrectly dismissed as belated its argument under §§ 102(f) and 103 that the claims of Moore are unpatentable to Moore because Bartz filed no motion for judgment under 37 CFR § 1.633(a). Unpatentability under §§ 102(f), 103 and derivation in an interference proceeding are different issues and, consequently, the exception provided under 37 CFR § 1.633(a)(2) that a motion shall not be based on derivation of the invention from the moving party does not apply here. Furthermore, 37 CFR § 1.633(a) is recognized as authorizing a party in interference to move for judgment on the ground that the opponent's claims are unpatentable under § 102(f). Kramer v. Ballard, 11 USPQ2d 1148, 1150 (Comm'r Pats. & Trademarks 1989).

We note that at the time of the preliminary motions period, 37 CFR § 1.639(c) provided

that if a party believes that additional evidence in the form of testimony that is unavailable to the party is necessary to support a preliminary motion under § 1.633, the party shall describe the nature of any proposed testimony and that the Administrative Patent Judge may grant appropriate interlocutory relief and enter an order authorizing the taking of testimony. Code of Federal Regulations, July 1, 1998. The rule does not preclude preliminary motions which require the taking of testimony but, in fact, provides for such motions. Accordingly, no merit is found in the argument of Bartz that it could not have filed a motion for judgment under 37 CFR § 1.633(a) charging unpatentability under 35 U.S.C. §§ 102(f) and 103 because the motion would have required the taking of testimony.³

Item II.

In Item II of its request at pages 6-9, Bartz argues that the Board erred in refusing to consider its position of joint inventorship with the party Moore because Bartz filed no timely motion to correct inventorship under 37 CFR § 1.634. The position is taken that “. . . until the Board rendered its Final Decision on derivation, the question of joint inventorship was not ripe.” Bartz submits that the requirements of § 1.324 could not be met because the party Moore inventors would not have cooperated in filing statements that the inventorship error occurred without any deceptive intention.

The first argument made by Bartz is not persuasive because a party cannot wait until after the Board has rendered a decision against him and then subsequently present new contentions in the proceeding. Moller v. Harding, 214 USPQ 730, 751 (Bd. Pat. Int. 1982); *aff’d w/o pub.*

³ With regard to the matter of taking testimony, to establish derivation of the invention by an opponent from the moving party in an interference proceeding, there must be a complete conception of the invention in order to disclose it to another. Davis v. Reddy, 620 F.2d 885, 889, 205 USPQ 1065, 1069 (CCPA 1980). In contrast, to establish unpatentability under §§ 102(f) and 103, it must be established that subject matter derived by a party from another, when combined with other prior art, makes a resulting obvious invention unpatentable to that party. OddzOn Products Inc. v. Just Toys Inc., 122 F.3d 1396, 1403-04, 43 USPQ2d 1641, 1646 (Fed. Cir. 1997). In order to establish unpatentability under §§ 102(f) and 103, there is no requirement that the party from whom the subject matter was derived had a complete conception of the invention. Thus, establishing unpatentability under §§ 102(f) and 103 is less stringent than establishing derivation in an interference of the invention by a party from an opponent.

opinion, 714 F.2d 160 (Fed. Cir. 1983). Furthermore, a change of opinion or purpose does not constitute good cause for excusing a belatedly raised issue. Suh v. Hoefle, 23 USPQ2d 1321, 1324 (Bd. Pat. App. & Int. 1991).

The other argument made by Bartz also fails to be persuasive. Bartz is correct that statements of all the inventors are required to satisfy the requirement of § 1.324 to change inventorship. Nevertheless, a party to an interference that is unable to obtain a signature of an inventor necessary to support a motion to correct inventorship in an application or patent is not without remedy, since an interference is a contested case within the meaning of 35 USC § 24, and since deposition testimony of a third inventor can be compelled through issuance of a subpoena under § 24. Davis v. Uke, 27 USPQ2d 1180, 1184 (Comm'r Pats. & Trademarks 1993). Such deposition testimony could have been utilized by Bartz in an attempt to establish that the junior and senior parties are joint inventors.

Item III.

Bartz contends that it has established good cause why the issue of patentability of Moore's claims under §§ 102(f) and 103 was not raised by a timely filed motion under 37 CFR § 1.633(a) and that the issue should have been decided by the Board at final hearing.

This contention is the same as that set forth in Item I and it is found unpersuasive for the same reasons we rejected the arguments in Item I.

Item IV.

In Item IV, pages 10 and 11, of its request, Bartz submits that it argued in its reply brief at page 17 that in the interest of justice the Board should entertain its arguments raised at final hearing of unpatentability under §§ 102(f), 103 and joint inventorship by the junior and senior parties. It is urged that the Board should have decided these issues in the interest of justice.

We are not persuaded by this position because Bartz did not timely present its argument. Bartz should have made its assertion in its main brief, not only in view of the requirement of

37 CFR § 1.656(b) that the main brief for the junior party shall present a full fair statement of the questions involved, but also as a matter of fundamental fairness to the senior party, providing the senior party opportunity to present its views on all grounds. Von Brimer v. Whirlpool Corp., 536 F.2d 838, 190 USPQ 528, 21 Fed. R. Serv. 2d (Callaghan) 1385 (9th Cir. 1976); McLaughlin v. Roberts, 197 USPQ 831 (Bd. Pat. Int. 1978); Suh v. Hoefle, 23 USPQ2d 1321 (Bd. Pat. App. & Int. 1991).

Items V. and VI.

In the above items, Bartz argues the merits of its position that Moore's claims are unpatentable under §§ 102(f) and 103, and that the junior and senior parties are joint inventors. Whereas these issues have not been reached by the Board and stand dismissed, they are not entitled to consideration on reconsideration from our final decision.

Bartz's request for reconsideration is granted to the extent of the above reconsideration but is denied as to making any change in our decision.

STANLEY M. URYNOWICZ, JR.)	
Administrative Patent Judge)	
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JOHN C. MARTIN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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Interference No. 104,180

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